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GEORGE O. SAILE & ASSOCIATES 28 DAVIS AVENUE POUGHKEEPSIE, NY 12603			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/579,789

Applicant(s)

REIFEL ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment of 10-30-03 amended claims 1 – 5, 8 – 10, 12 – 16, 19, 23, 26 – 30, 35, 40 – 42, 51, 57, 71 – 73, 77 and 84 - 85 as well as traversed rejections of Claims 1 - 95.

Currently, claims 1- 95 are pending.

### ***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In Claims 1 - 56, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 6 – 11, 19 – 28, 30 – 47, 49 – 58, 62 – 68, 70 – 78 and 82 – 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander (US 5,963,752) in view of Segal (US 6,167,251) and further in view of Enomoto (US 5,974,401).**

Regarding claims 1 and related claims 10, 35, 40, 42, 57 and 77, the combination of Zander, Segal and Enomoto teach a method, system and computer medium for – where Zander teaches providing cameras to consumers in exchange for a commitment (see at least Zander, Abstract), comprising the steps of creating a contractual relationship between a camera provider and a consumer, where said consumer acquires at least one camera in exchange for said commitment (see at least Col 5, lines 46 – 64). Please note Zander does not specifically refer to a contract. However, Zander does state a rental option (Col 5, line 49). In that regard, it is old and well known to one of ordinary skill in the art at the time of the invention that to rent a camera, the merchant is going to require a rental agreement (i.e. contractual relationship), which will stipulate a return date as well as an amount. Moreover, Zander is - determining that the consumer has at least one of a plurality of financial instruments (see at least Col 5, lines 46 – 48); and providing the consumer with the camera, in response to the consumer entering into the commitment and determining that said consumer has at least one of the plurality of financial instruments (see at least Col 5, lines 46 – 52). Regarding claim 43, Zander

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teaches a method of providing a camera to a user (see at least Abstract). In addition and regarding claim 46 and related claim 87, Zander teaches a method further comprising the steps of transferring personal information from said consumer to said camera provider; and retaining said personal information within a consumer database (see at least Col 1, line 55) and (47 and related claims 11, 47, 56, 68 and 88) wherein said personal/user information comprises; consumer name consumer identification code; mailing address; billing address; e-mail address; other contact information such as phone numbers and fax numbers: billing information including credit card information: preferred print image provider: reprint / enlargement size preference: reprint / enlargement size preference: finish preference: camera brand, type, and specifications; internet service type and connection speed: contract data picture development and reproduction counters number of prints remaining to meet contract commitment: security settings unlocking keys, activation code: and usage pattern information (Col 1, line 55). Please note that Zander is silent regarding all the different fields that can be available for filling out in a database application for a user/consumer – as claimed. However and as noted by Zander, information is entered by the retailer (Col 1, line 55), which would have to be database in order to retain the necessary information regarding the customer and the agreement. Moreover, a database can have as many fields as necessary for filling in information required to service the customer agreement and this technique of multiple fields available for entering information in databases as has been old and well know in the data processing art for years. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the

invention to provide the method of Zander with these capabilities such as appropriate fields and storing in a database in order to capture the necessary information deemed important/significant to the camera provider. In addition and regarding claims 31 - Please note, Zander is silent to the business entity providing the camera. However, it is well known that the provider could have been a print house as well as the camera manufacturer and is reflected in the business entity assignee for the Zander patent. Therefore, it would have been obvious to have either a print house or a manufacturer to provide the camera as part of the incentive program. Regarding claim 36(Original), Zander teaches a method, wherein the camera is rented at an automated kiosk (Figure 1) and (37) wherein the user is charged an additional fee if the camera is not returned within a predetermined amount of time. Please note Zander is silent regarding charging additional fee for late returns of the camera. However, Zander does describe, "renting" a camera and it is old and well known that a consumer is charged an additional fee if the rented item is returned late. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have rental agreement include a late fee charge – in order to ensure timely returns. Regarding claims 53, 74 and 94, Zander teaches wherein the camera provider and the image processor are associated with the camera manufacturer (Figure 1). With regard to claim 67, Zander teaches a system further comprising a consumer database in communication with the camera provider retaining personal information transferred from said consumer to said camera provider (see Col 1, line 55).

However Zander does not specifically disclose and teach wherein said contractual relationship terms for: offering by said camera provider to provide said camera for a commitment by the consumer to purchase at least a first amount of image reproductions within a selected amount of time, and committing by said consumer to purchase at least the first amount of image reproductions within the selected amount of time; and restricting access to images acquired from the camera to prevent the consumer from obtaining reproductions of the images made from a source not associated with the camera provider.

On the other hand, Segal teaches a method wherein said contractual relationship terms for: offering by said camera provider to provide said camera for a commitment by the consumer to purchase at least a first amount of image reproductions within a selected amount of time, and committing by said consumer to purchase at least the first amount of image reproductions within the selected amount of time (see at least Col 1, lines 16 – 58 and Col 12, lines 25 – 44). Please note that Segal does not disclose a camera, rather a cellular phone. However, Segal does disclose a method for offering a physical device such as cell phone or could be a camera for a commitment to purchase at least a first amount of image reproductions or in this case air time and committing by said consumer to purchase at least the first amount of image reproductions with the selected amount of time. Furthermore, online methods and systems for offering a physical device such as a camera that a kind/type including such specifics as “camera” are given little patentable weight. The phrase(s) and or word(s) are given little patentable weight

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because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Segal. Thereby, the non-fictional descriptive material is directed only to the product – a camera and which could also be a cellular phone and therefore does not affect either the structure or method/process of Segal, which leaves the method and system unchanged. Additionally, the applicant stated in the amendment that “the major features of the invention, which is a novel system and method – “where a camera provider offers to provide cameras, such as digital cameras or film cameras, to consumers free or at a discount cost in exchange for the purchase of certain number of image reproductions or prints” is old and well known. For example, Segal does address all the above method steps in terms of incentivizing a consumer to buy a product – which they receive upfront for free or reduced fee, if they commit to a contractual arrangement to purchase an additional number of items/photos or minutes (see at least Segal Col 1, lines 55 – 58 and Col 9, lines 13 - 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system disclosed by Segal to include offering a digital camera to a consumer if they commit to purchase a specific number of photographs. In this manner the consumer's satisfaction will be increased due to obtaining a camera, which will increase the probability that they will recommend the service to others and take more photographs. In addition, the camera maker will increase the probability of distributing more cameras as well as the developer increasing their business as well. Furthermore, Segal teaches restricting access to images acquired from the camera to prevent the consumer from obtaining reproductions



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of the images made from a source not associated with the camera provider (Col 1, lines 16 – 24 and lines 40 – 43). Please note and as indicated above, Segal does not specifically address cameras. Segal does however address all the above method steps in terms of limiting access of the device/phone to only the offer's service in order to prevent the consumer from being able to use any other service for airtime. In this manner, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Segal with a capability to restrict access to photographs to ensure the consumer can only use to the business entity, which supplied the device/camera at a reduced fee. Therefore, the camera maker will be assured that they will at least recoup their initial investment by limiting access of the consumer to just their service.

regarding claim 9 and related claims 65 and 85, Segal teaches a method, wherein the camera is provided, at least partly, in response to an amount paid by the consumer for the camera, wherein the amount is related to the number of reproductions the consumer committed to purchase (Col 1, lines 17 – 24 and lines 29 – 32 and 46 – 56).

regarding claims 20, 21, 22, 24, 25, 33, 34, 41, 50 and related claim 91, claims 51 – 52 and claims 71, 72 and 73 as well as claims 92 - 93, the recitations that “wherein the type of camera provided is based at least in part on the extent of the commitment”, “wherein the first amount is a dollar amount”, “wherein the first amount is a quantity of image reproductions”, “wherein the commitment is to be fulfilled within a predetermined

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amount of time", "fixing the price to the user of at least a first type of image reproduction for at least the predetermined amount of time", "wherein the camera is provided with no initial cost or charge to the user", "wherein the camera is provided at a reduced cost to the user in exchange for the commitment", "where the camera manufacturer provides the camera at a discount in return for a commitment on the part of the distributor that the camera manufacturer will be paid said at least first amount", " wherein the Camera provider discounts the price of said camera for committing by said consumer of the purchase of at least the first amount of image reproductions", "wherein the camera provider leases said camera for committing by said consumer of the purchase of at least the first", "wherein the Camera provider said camera at not cost for committing by said consumer of the purchase of at least the first amount of image reproductions", "wherein the camera provider discounts the price of said camera for committing by said consumer of the purchase of at least the first amount of image reproductions", "wherein the camera provider leases said camera for committing by said consumer of the purchase of at least the first amount of image reproductions", " wherein the camera provider offers said camera at no cost for committing by said consumer of the purchase of at least the first amount of image reproductions" and wherein the camera provider leases said camera for committing by said consumer of the purchase of at least the first amount of image reproductions" as well as "wherein the camera provider said camera at no cost for committing by said consumer of the purchase of at least the first amount of image reproductions" such recitations are given little patentable weight because they

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impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other "commitments" already disclosed by Segal.

Please note and regarding claims 32 and 40; Zander and Segal do not specifically mention a distributor providing a manufacturer a fee/markup based on image reproduction sales. However, it is old and well known for distributors and manufacturers to establish contract agreements based on each marketplace's most efficient channels of distribution - to best service the consumer(s) and to ensure product sales for the purpose of mutual revenue generation. Therefore it would be obvious for a distributor and/or manufacturer to establish such a contract in order to increase current and future sales for both parties and share profits.

Please note and regarding claim 39(Original), Zander and Segal are silent regarding "wherein an additional fee is charged for orders costing more than the first fee". It is old and well known that the customer who increases their order such as having additional prints made or additional minutes – will pay more fee when the order is outside or in addition to a previous order and/or agreement. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Zander and Segal with capability as with any commercial transaction to increase fees on orders as warranted.

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Please note and regarding claim 44, the combination of Zander and Segal are silent regarding selling the camera to the user at the end of a specific time period. However, Zander does address purchasing (see Col 2, line 7), which teaches a method of providing a camera to a user, further comprising selling the camera to the user after a first period, which have included selling the rented camera to the consumer/user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Zander and Segal with the ability for the consumer to buy the camera at the end of the rental/incentive program time period.

Please note and regarding claim 49 and related claims 70 and 90, Zander and Segal are silent regarding a method further comprising the step of providing coupons to said consumer based on said personal information. However, it was old and well known at the time of the invention that a merchant and/or advertiser would have and/or did provide coupons based on supplied personal information – in order to incentivize and compensate the consumer for taking the time to supply the provided/advertiser with the required information. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander and Segal with a method of providing coupons to a consumer – in return for providing personal information.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Zander with the method and system of

Segal wherein said contractual relationship terms for: offering by said camera provider to provide said camera for a commitment by the consumer to purchase at least a first amount of image reproductions within a selected amount of time, and committing by said consumer to purchase at least the first amount of image reproductions within the selected amount of time; and restricting access to images acquired from the camera to prevent the consumer from obtaining reproductions of the images made from a source not associated with the camera provider – in order to provide a device such as camera for the consumer agreeing to purchase a first amount of images as well as limiting the consumer access. In that regard, the provider will be assured of recovering at least their cost, which ensure that they can continue the offer for consumers. Moreover, customer satisfaction will be increased because the consumer is able to obtain a camera at a reduced cost as a part of the normal process of having the images developed. Indeed, this increased customer satisfaction will increase the probability too - that the consumer will recommend the service at the site to others.

The combination of Zander and Segal substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach transferring from said consumer images acquired by said camera to an image processor. Nor does the combination specifically disclose and teach printing reproductions of at least one of the images having restricted access.

On the other hand, Enomoto teaches transferring images acquired by said camera to an image processor (see at least Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1) and printing reproductions of at least one of the images having restricted access (Col 7, lines 48 – 49). Please note that in online methods and systems for printing online or offline that a kind/type including such specifics of the printing such as “having restricted access” is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Enomoto. Thereby, the non-fictional descriptive material is directed only to the content of the data/information to be printed (. i.e. having restricted access - which is stored data) and does not affect either the structure or method/process, which leaves the method and system unchanged.

Moreover:

regarding claim 23, Enomoto teaches a method, further comprising: receiving user profile information; and storing at least a portion of the user profile information in the camera (see at least Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1).

regarding claim 26, Enomoto teaches a method, further comprising the step of receiving an order for hard copy image reproductions, where the user places the order using a

camera user interface (see at least Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1).

regarding claim 27, Enomoto teaches a method, further comprising the step of receiving an order for hard copy image reproductions over a network (see at least Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1).

regarding claim 28, Enomoto teaches a method, further comprising the step of receiving over a network images taken with the camera and receiving camera setting information associated with the images (Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1).

regarding claim 30, Enomoto teaches a method, further comprising the step of receiving a designation from the user as to which print house is to print images ordered by the user (see at least Abstract, Col 2, lines 10 – 31, Col 3, lines 21 – 30 and Figure 1).

Please note and regarding claim 38, Enomoto is silent regarding a method, wherein the computer is located remotely from where the camera was rented. However and in combination with Zander and Segal, the camera could have been available separately from the computer as in vending kiosk and connected with via a network, which was old and well known at the time of the applicant's invention. In that manner, the consumer could have rented/purchased the camera from a kiosk remotely – as taught by the

combination of Zander and Segal. Thereby increasing additional sales as well as convenience for the consumer.

Please note regarding claim 54 and related claims 75 and 95, Enomoto is silent with respect to a method further comprising the step of reviewing by the consumer of said images acquired by said camera; and selecting desired images acquired by said camera for reproduction. However, it is well known in the consumer's selection process to choose the pictures that they wish to have developed. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander, Segal and Enomoto with a process for the consumer to select only the pictures that they wish to have developed. In this manner, the consumer's satisfaction will be increased as a result of saving money.

regarding claim 55 and related claims 76 and 96, Enomoto teaches a method wherein said images acquired by said camera are retained in an image database of said image processor (Col 8, lines 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander and Segal with the method, system and medium of Enomoto to enable transferring images acquired by said camera to an image processor as well as printing of images with restricting access – in order to provide an online developing service which only allows access to images as well as reproducibility



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of the images. In that regard, the consumer's convenience and ease of access as well as printing will be increased, thereby increasing their satisfaction. Moreover, the consumer as a result of their increased satisfaction will be more likely to use additional provided services as well as recommend the service to others. As importantly, the provider of the device/camera will be assured of at least recouping their investment.

Please note and regarding claim 2 with related claims 58 and 78 as well as claim 8 and related claims 64 and 84, the above combination is silent with respect to both allowing images to be taken with the camera to be displayed on the a camera display – as well as receiving image information such as ISO, aperture or shutter speed information in association with an encrypted image. It is old and well-known for digital camera's to provide the capability to allow images to be displayed on the camera (please see Parulski US 6,573,927 B2) and to provide information about films and cameras when submitting a film order for photo processing, such as whether the camera is a 135 mm type, and it would have been obvious to one of ordinary skill to provide such camera with display capabilities as well as information to aid in better print processing of an order or image reproduction by a photo processor and increase consumer satisfaction, which thereby will increase the probability that the consumer will return for additional purchases.

**Claims 3, 59 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zander, Segal and Enomoto as applied to claims 1, 57 and 77 above, and further in view of Sheridan (US 5,760,917).**

The combination of Zander, Segal and Enomoto substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a method, further comprising allowing low resolution versions of images taken with the camera to be transferred from the camera.

Regarding claims 3 and related claims 59 and 79, Sheridan teaches a method, further comprising the step of allowing low-resolution versions of images taken with the camera to be transferred from the camera (see at least Col 5, lines 34 – 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention have provided the combination of Zander, Segal and Enomoto with the method of Sheridan to have enabled transfer of low resolution versions of the images – in order to ensure that these will not serve for the customer as the final prints, due to lack of clarity. In this manner, the provider of the service can be assured that consumer will have to use their developing capabilities and thereby protect their investment(s).

**Claims 4, 5, 60 – 61 and 80 - 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zander, Segal and Enomoto as applied to claims 1, 57 and 77 above, and further in view of Bezos (US 6,029,141).**

The combination of Zander, Segal and Enomoto substantially disclose and teach the applicant's invention.

However the combination of Zander, Segal and Enomoto does not specifically disclose and teach a method further comprising: receiving an order for an image print from someone other than the consumer; and crediting the consumer's commitment fulfillment based on the order and receiving an order for an image reproduction from someone other than the consumer, and providing the consumer a benefit based on the order.

On the other hand and regarding claim 4 and related claims 5, 60, 61, 80 and 81, Bezos teaches a method, further comprising: receiving an order for an image print from someone other than the consumer; and crediting the consumer's commitment fulfillment based on the order (see at least Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander, Segal and Enomoto with the method, system and medium of Bezos to have enable receiving an order for an image print from someone other than the consumer; and crediting the consumer's commitment fulfillment

based on the order and receiving an order for an image reproduction from someone other than the consumer, and providing the consumer a benefit based on the order – in order to provide a financial reward to the consumer for purchases by others. In this manner, it would facilitate potential additional sales, which will benefit - with increased revenues all the channel partners offering this incentive program. Please note, methods and systems for “receiving an order” including such specifics as “ for an image print” is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Enomoto. Thereby, the non-fictional descriptive material is directed only to the content of the “received order” and therefore does not affect either the structure or method/process of Enomoto, which leaves the method and system unchanged.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander, Segal and Enomoto with method of Frey to have enabled selecting advertising to be presented to the user based at least in part on the camera usage information and downloading an advertisement into the camera and displaying the advertisement on a camera display as well as providing advertising to said consumer based on said personal information – in order to provide relevant advertising tailored to the consumer. In this manner, it would have provided potential useful information to the consumer as well as potentially increasing sales for the provided – as well generating additional revenues from advertisers.

**Claims 6, 7, 19, 45, 62 – 63, 66, 82 – 83 and 86 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zander, Segal and Enomoto as applied to claims 1, 10, 57 and 77 above, and further in view of Steinberg (US 6,587,949 B1).**

The combination of Zander, Segal and Enomoto substantially teach the applicant's invention.

However, the combination does not specifically disclose and teach a method, wherein the secured first image is received from a terminal to which the first image has been transferred from the camera; and wherein images taken by the camera are secured by the camera until the consumer has fulfilled the commitment and an unlocking code has been received by the camera; and wherein the secured first image is received from a terminal to which the first image has been transferred from the camera; and wherein images taken by the camera are secured by the camera until the consumer has fulfilled the commitment and an unlocking code has been received by the camera; and further comprising the step of encrypting by the camera of at least a first image captured by said camera to prevent the user from having prints of at least the first image from a source not associated with a provider of said camera -as well as wherein the image securing device encrypts said first image.

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On the other hand and regarding claim 7 and related claims 63 and 83, Steinberg teaches a method, wherein images taken by the camera are secured by the camera until the consumer has fulfilled the commitment and an unlocking code has been received by the camera. Please note that Steinberg is silent regarding the consumer not receiving an unlock code until after fulfilling their commitment. As noted previously, Segal fully addresses the commitment and this claim is an obvious variation. Therefore, the combination of Segal and Steinberg would have provided this feature and thereby it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Steinberg with the method of Segal – in order to only provide the camera unlocking code only after the consumer has fulfilled their commitment. Therefore assuring the ability to at least recoup the investment of the channel partners in this marketing program.

Regarding claim 19 and related claims 45 and 86, Steinberg teaches a method, further comprising the step of encrypting by the camera of at least a first image captured by said camera to prevent the user from having prints of at least the first image from a source not associated with a provider of said camera (see at least Abstract and Col 2, lines 37 – 42).

Regarding claim 66, Steinberg teaches a system wherein the image-securing device encrypts said first image (see at least Abstract).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have provide the combination of Zander, Segal and Enomoto with the method, system and medium of Steinberg to enable securing at least a first image taken with acquired camera to prevent the consumer from obtaining the first image made from a source not associated with the camera provider - in order to ensure that the entity offering the incentive will recoup their initial investment. Without this ability to recoup the initial investment for the incentive program, the business entities will not be able to ensure themselves and other sponsors – such as a camera manufacturer, advertisers and/or a film producer of an ability to recoup their initial investment.

**Claims 13 –18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Zander, Segal and Enomoto as applied to claims 11 and 10 above, and further in view of Fitchtner (US 6,360,362).**

The combination of Zander, Segal, Enomoto and Steinberg substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a method further comprising modifying camera performance based at least in part on the camera usage information; and predicting camera battery life based at least in part on the number of pictures taken with the camera during a predetermined time period; and predicting when camera memory will be full based at least in part on the number of pictures taken with

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the camera during a predetermined time period; and modifying camera energy management based at least in part on -the number of pictures taken with the camera during a predetermined time period; and wherein at least a portion of the camera usage information is stored in camera memory; and wherein at least a portion of the camera usage information is stored on a server associated with a Web site.

On the other hand and regarding claim 13, Fitchtner teaches a method further comprising the step of modifying camera performance based at least in part on the camera usage information (see at least Abstract, Col 1, lines 11 – 53 and Col 7, line 65 as well as Col 8, line 27).

Regarding claim 14, Fitchtner teaches a method, further comprising the step of predicting camera battery life based at least in part on the number of pictures taken with the camera during a predetermined time period (see at least Abstract, Col 1, lines 11 – 53 and Col 7, line 65 as well as Col 8, line 27).

Regarding claim 15, Fitchtner teaches a method, further comprising the step of predicting when camera memory will be full based at least in part on the number of pictures taken with the camera during a predetermined time period (see at least Abstract, Col 1, lines 11 – 53 and Col 7, line 65 as well as Col 8, line 27).



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Please note and regarding claim 16 and 17, the combination of Zander, Segal and Enomoto as well as Fitchtner are silent regarding predicting when camera battery life or memory space will be exhausted based on the number of pictures taken during a predetermined time period. However, it is old and well known in the camera art to display on a camera the number of pictures taken versus the total number of pictures possible, as well as displaying a low battery state of the camera. It would be obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander, Segal, Enomoto and Fitchtner with the capability to predict the camera's condition based in displayed camera indicators generated from, in the case of a digital camera, data stored in the camera's memory.

Regarding claim 18, Fitchtner teaches a method as defined, wherein at least a portion of the camera usage information is stored on a server associated with a Web site (see at least Abstract, Col 1, lines 11 – 53 and Col 7, line 65 as well as Col 8, line 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Zander, Segal Enomoto with the method of Fitchtner to have enabled modifying camera performance based at least in part on the camera usage information; and predicting camera battery life based at least in part on the number of pictures taken with the camera during a predetermined time period; and predicting when camera memory will be full based at least in part on the number of pictures taken with the camera during a predetermined time period; and modifying

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camera energy management based at least in part on the number of pictures taken with the camera during a predetermined time period; and wherein at least a portion of the camera usage information is stored in camera memory; and wherein at least a portion of the camera usage information is stored on a server associated with a Web site – in order to automatically upgrade a camera's software and/or hardware, thereby ensuring that the upgrade is performed correctly. With these capabilities, the customer's satisfaction will be increased, which will increase the probability of increased sales as well as the consumer recommending this service to others.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 - 95 have been considered but are moot in view of the new ground(s) of rejection. With regard to applicants arguments:

1. Applicant argues under the 35 USC 101 rejections that the claims are "useful, tangible and concrete".

In response to applicant's arguments, overcoming 35 USC 101 rejections is not just based on whether the claims are "useful, tangible and concrete" but also must address and incorporate within the body of the claim the technological arts.

2. Applicant argues that the rejection for all the claims was based on the fact that each reference cited is lacking certain claim limitations.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. There is not sufficient basis for concluding that the combination of these references addressing the claim limitations would have been obvious to one of ordinary skill in the art.

Further in response to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reasons to combine were provided in the above rejection.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

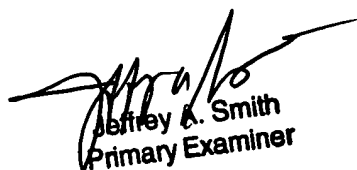
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER



Jeffrey A. Smith  
Primary Examiner